

VII. ARGUMENT

A. Claim 21 is not anticipated by Gamow.

The Examiner states that “claim 21 only requires the chamber be capable of being mounted on the roof of the building.” (page 11).

Claim 21 does not say “capable of being mounted” but rather says “adapted for mounting.” The language “adapted for” limits the claim scope to the device of Gamow being mounted on the roof of the building, according to MPEP 2111.04.

I. 2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3]

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.'" *Id.*<

See also *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990) (holding that language such as “adapted to” constituted structural limitations).

The “adapted for” language is material to patentability and constitutes a structural limitation. Gamow does not show the device mounted on the roof of the building. Therefore, Claim 21 is not anticipated by Gamow.

B. Claims 1-4 and 8 are not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow.

The Examiner argues that Gamow is not non-analogous prior art.

Appellant reminds the Board of the following argument which was submitted in the Appeal Brief:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances (citation omitted) -- in other words common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor."¹ (emphasis added)

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.²

As stated in the Appeal Brief, common sense would dictate that a person of ordinary skill in the art seeking to solve the problem of a door and frame in combination with an air handling unit mountable on the roof of a building to withstand the pressure differential caused by gale force winds, would not reasonably be expected to look for a solution to his problem in the field of hypobaric body chambers (See Gamow, Field of the Invention). The circumstances are totally different, and such a person would not be reasonably motivated to go to the field of Gamow to solve the problem. A person in the art of the invention in all probability would not even know that such things as hypobaric body chambers exist. Such a person would likely be knowledgeable of building construction, but certainly not of such a highly technical field as the Gamow reference. In fact, the Examiner, with all of the resources of the Patent and Trademark Office at his disposal, has not produced a more

¹ In re Hans Oetiker, 977 F.2d, 1443, 1447

² Id.

analogous reference than Gamow. How, then, is Appellant supposed to look for a solution to his problem in Gamow's field?

Gamow is therefore clearly non-analogous art.

- D. Claims 9-11 and 15 are not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow.

As discussed above, Gamow is non-analogous art.

Claim 9 is therefore allowable.

Claims 10-11 and 15 are dependent on allowable claim 9 and are therefore also allowable.

- E. Claims 16, 17, 19, and 20 are not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow and further in view of Colliander and Jansen.

In addition to the fact that Gamow is non-analogous art, Jansen does not disclose opposed thermal pockets in the door and in the frame, the thermal pockets being filled with high-density polyurethane. Jansen only discloses a thermal pocket between the outer wrapper and inner liner of a refrigerator cabinet. There is no apparent disclosure of an opposed thermal pocket in the door.

The Examiner has answered that:

One of ordinary skill in the art, when presented with the teachings of Jansen, would be motivated to provide a high density polyurethane foam throughout the structure of the admitted prior art of figure 1, i.e., both the frame and the door.

However,

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination...Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (MPEP 2143.01) (emphasis supplied)

There is no suggestion or motivation in Jansen to modify the reference as suggested by the Examiner.

The Examiner also states:

Additionally, McDonald discloses that it is well known to provide both the frame of a structure and a door with insulated pockets.

Even if this true, the Examiner did not cite any such teaching in the rejection over McDonald.

Also, Gamow does not teach a seal capable of withstanding a pressure differential of greater than 11 inches. Gamow can only withstand a pressure difference of about 0.1 to about 10 psi below ambient. See Abstract, Col. 4 lines 37- 41.

Claim 16 is therefore allowable.

Claims 17, 19, and 20 are dependent on claim 16 and are therefore also allowable.

F. Claim 5 is not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow and further in view of Colliander.

Claim 5 is patentable over the cited references because Gamow is non-analogous prior art, as discussed above.

Claim 5 is therefore allowable.

Claim 5 is also allowable in that it is dependent on allowable claim 1.

G. Claims 6 and 7 are not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow and further in view of Jansen.

Claims 6 and 7 are allowable in that they are dependent on allowable claim 1.

In addition to the fact that Gamow is non-analogous art, Jansen does not disclose opposed thermal pockets in the door and in the frame, the thermal pockets being filled with a second insulating material. Jansen only discloses a thermal pocket between the outer wrapper and inner liner of a refrigerator cabinet. There is no disclosure of a thermal pocket in the door.

See the rebuttal to the Examiner's Answer with respect to claims 16,17, 19, and 20 above.

H. Claim 12 is not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow and further in view of Colliander.

Claim 12 contains additional elements or limitations beyond allowable claim 9 and is therefore also allowable.

Claim 12 is also patentable over the cited prior art because Gamow is non-analogous prior art.

- I. Claims 13 and 14 are not unpatentable under 35 USC 103(a) as being obvious over admitted prior art in Fig. 1 in view of McDonald, Ryan, and Gamow and further in view of Jansen.

Claims 13 and 14 are allowable in that they are dependent on allowable claim 9.

In addition to the fact that Gamow is non-analogous art, Jansen does not disclose opposed thermal pockets in the door and in the frame, the thermal pockets being filled with a second insulating material. Jansen only discloses a thermal pocket between the outer wrapper and inner liner of a refrigerator cabinet. There is no disclosure of a thermal pocket in the door.

See the rebuttal to the Examiner's Answer with respect to claims 16,17, 19, and 20 above.

Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*³ The MPEP requires the Examiner to do so.⁴ However, the Examiner has made no finding of the level of ordinary skill in the art.⁵

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

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³ 383 U.S. 1 (1966)

⁴ MPEP § 2141

⁵ MPEP § 2141.03